

No. 9327

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

PAYNE FURNACE & SUPPLY COMPANY, INC., a
corporation,

Appellant,

vs.

WILLIAMS-WALLACE COMPANY, a corporation,

Appellee.

APPELLANT'S REPLY BRIEF.

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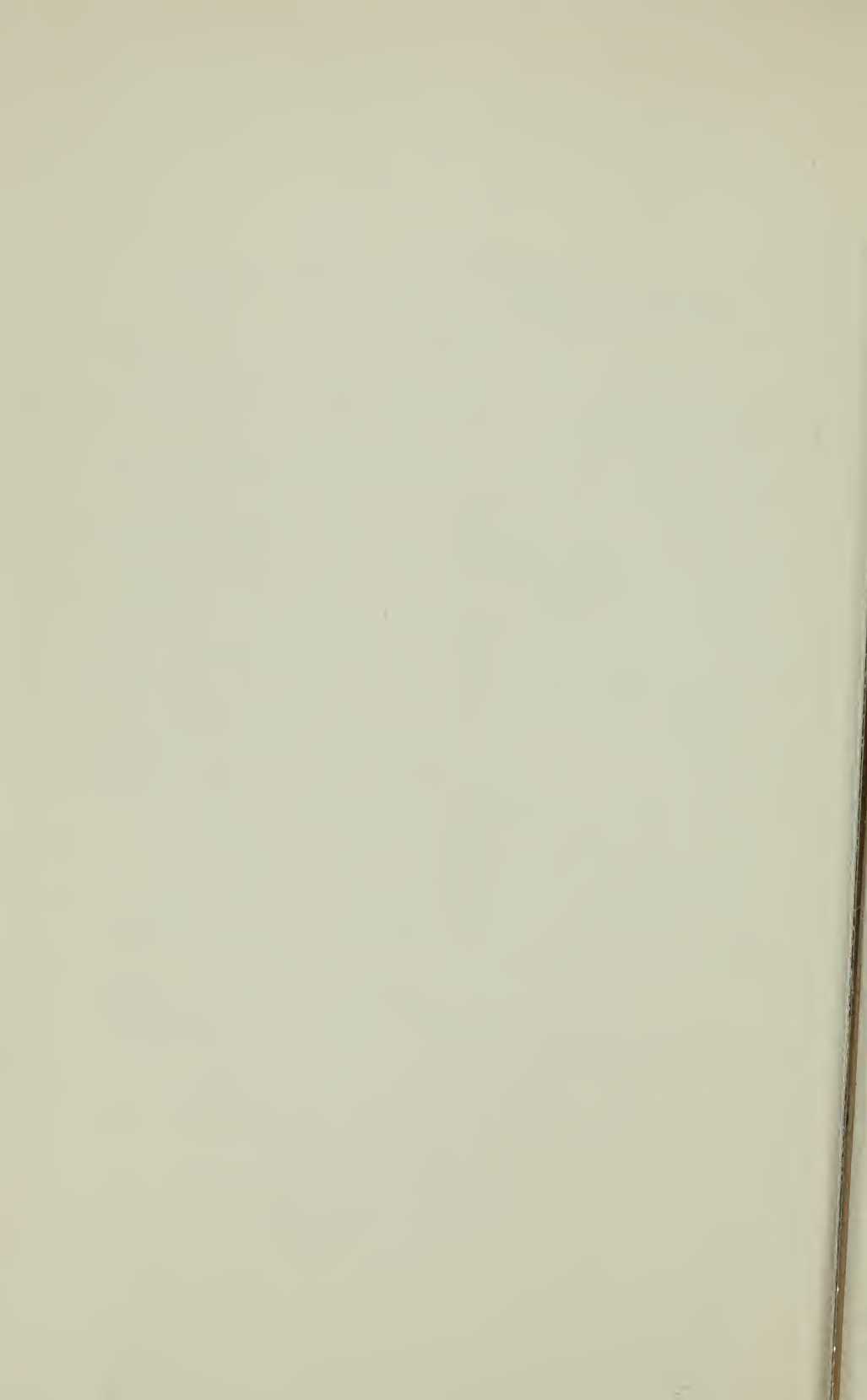
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APPELLANT'S REPLY BRIEF.

Appellee's brief reflects a total misapprehension of the disclaimer statute (*R. S. U. S., Secs. 4917 and 4922*). It fails to recognize the fact that the disclaimer statute is purely permissive, by which at his option and selection the patentee may disclaim that severable portion of the patent which is void, thereby avoiding the rule that a patent void in part is void in whole.

Appellee's brief seeks to make an unwarranted distinction between what it asserts is a "voluntary" or "voluntary precautionary" or "permissive" disclaimer and a disclaimer required by the statute. The statute does not require a disclaimer. The disclaiming is remedial and optional to the patentee. By availing himself of the permission of the disclaimer statute, the patentee may escape the result of having claimed more than was his inven-

tion. He may lose the entire patent if he does not disclaim. (Cf. *Ansten v. Simon Ascher & Co.*, 282 U. S. 445, 452, 75 L. ed. 453, 456.)

In an attempt to circumvent the invalidity of the disclaimer, appellee seeks to characterize it as something other than and different from a disclaimer authorized or permitted by the disclaimer statute. *R. S. U. S. 4917* contemplates that a disclaimer is proper only when a patentee has claimed more than that of which he was the first inventor, while *R. S. U. S. 4922* applies only to cases wherein the excess of his claim is a material or substantial part of *the thing patented*. The latter section applies, for example, where two or more claims, in substance, are combined in one by the use of the words "with or without" or by the use of the word "or" alone. In such case disclaimer may be made to expunge or excise one of these inventions from that claim without disturbing the other. (Cf. *Deller's Walker on Patents*, Vol. 2, Sec. 288, pp. 1293-94.) "When the specifications themselves distinguish between alternate forms, the patentee may disclaim one." (*Sachs v. Hartford E. S. Co.*, 47 F. 2nd 743, 746.) The patent claims of the Stadtfeld patent as granted do not contain any such inclusion of alternate forms or any claiming of alternate forms with the words "with or without" or the word "or" as differentiating the alternate forms. In fact, no alternate forms are even shown or described in the Stadtfeld patent, and it is obvious, therefore, that the patent claims could not contain any claim to alternate forms, because there is no foundation for any such claim in the Stadtfeld drawings or specification. We thus see that appellee cannot depend upon this rule. While appellee's brief refers to so disclaiming alternate forms, it is highly significantly illustrative of

the fallacy of appellee's argument that appellee does not assert—much less point out—any alternate forms specified in the patent claims or even described or shown in the drawings. Manifestly, disclaiming an alternate form or forms is not the reason or purpose or effect of appellee's disclaimer. Appellee's argument is merely a makeweight argument wholly inapplicable to the facts of the case at bar.

R. S. U. S. 4917 permits the patentee to disclaim where he "has claimed more than that of which he was the original or first inventor or discoverer". The filing of the disclaimer under this statute is an admission of this fact. This statute does not authorize a disclaimer unless based upon the inventor's "*claiming*" something *of which he was not the first or original inventor*. The statute does not authorize the use of a disclaimer to revise or revamp a granted patent. Appellee cannot be heard to assert that its disclaimer is not based upon the fact that some *thing claimed* by the patent was not the invention of Stadtfeld. A disclaimer cannot be used as a mere amendment of the patent. Only by reissue under *R. S. U. S. 4916* can an amendment be made. It would be impossible to sustain an assertion (even if made by appellee) that such male and female joints are in any manner claimed in the claims of the patent as granted. It is not material on this appeal who, other than the patentee, was the original or first discoverer of the part authorized to be excinded by his disclaimer. The material fact is that the patentee by a disclaimer so recognizes this fact and excinds from the patent the part claimed therein which was the invention of someone else at some previous time, *i. e.*, the combination called for by the respective patent claims. Under *Sections 4917 and 4922* the material fact is that the ex-

cinded part must be a separate and divisible part so that what is retained amounts to invention over what is excinded, because by the disclaimer the patentee voluntarily confesses that he was not the original or first inventor or discoverer of the excinded part. Looking further at *Section 4922* in particular, it is seen that the part retained must be “a material and substantial part of the *thing patented*,” and “definitely distinguishable from the parts claimed without right”. There are two requirements of this section: (1) that the part retained shall be a material, substantial part of *the thing patented*, and (2) that such part of *the thing patented* shall be definitely distinguishable from the *parts disclaimed*. The *thing patented* is the thing (in this case the “combination”) “particularly point(ed) out and distinctly claim(ed)” (*R. S. U. S. 4888; 35 USCA, Sec. 33*). It is too well settled to require the citation of authority, that that which is “patented” is that which is particularly pointed out and distinctly claimed in the claim. (*Cf. Altoona Pub. Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 488, 79 L. ed. 1005, 1012.) It necessarily follows, therefore, under this section that the part retained (1) *must have been claimed, i. e., “patented,”* in the patent as granted; and (2) *must be definitely distinguishable from the parts disclaimed*. Appellee’s brief totally ignores these plain specific requirements of the statute. It attempts to create and establish for itself a law under which it seeks to justify its restatement of the “combination” which it now desires to hold by the patent. It is clear, however, that such revamped and amplified patent claims, calling for *different combinations* from those particularly pointed out and distinctly claimed in the patent claims, have been created by appellee’s *ex parte* action without authority of

law and uncontrolled by any examining or patent-granting authority. Appellee thus seeks to create, without any governing action or supervision and without any law authorizing such action, such a patent as it now desires.

Appellee's brief repeatedly asserts that, "What the disclaimer does is to introduce structural limitations for each of the three elements," of the respective claims (Appellee's Brief, pp. 6, 28); that such disclaimer "merely restricts the elements of the claim to what is shown in the drawing and described in the specification," (p. 36); "every structural limitation introduced by the Stadtfeld disclaimer is taken directly from the specification of the patent only to modify the original three elements in the claims without adding new elements" (pp. 35-36); "The disclaimer voluntarily limited the tubes to those described in the patent having male and female ends" (p. 38); "only necessary to introduce structural limitations to these three elements" (p. 40). There is no substantial denial of the mechanical fact that the disclaimer adds elements to the patented claims, as particularly pointed out and demonstrated in Appellant's Opening Brief, pp. 16-23. Appellee's purported denial that the disclaimer added any new element is entirely based *upon the hypothesis that anything described in the specifications or shown in the drawings of the patent is not a new element and can be added to the patent claims*. This is clear error. The *Altoona Pub. Theatres v. American Tri-Ergon Corp.* case demonstrates the utter fallacy of appellee's argument. In that case the Supreme Court held "the fly-wheel claims" (Nos. 5, 7, 17, 18 and 19) invalid as not disclosing invention (*Cf.* 294 U. S. 479, 480, 79 L. ed. 1008). The issued disclaimer applied only to claims 9 and 13 (294 U. S. 488, 79 L. ed. 1013). It was the attempt *to add by disclaimer* the fly-

wheel, (not only shown and described in the specification and drawings of the Vogt, *et al.* patent but claimed in claims 5, 7, 17, 18 and 19 thereof,) to claims 9 and 13 that was held an invalid disclaimer. So here although, for example, the male and female joints or fittings are shown in the drawings and are described in the specification, these facts do not make them parts of the combination specified in the patent claims and the disclaimer statute does not authorize their addition to the patent claims, precisely as such facts did not authorize the addition of the fly-wheel to claims 9 and 13 in the *Altoona Pub. Theatres* case.

The principle was established in *McCarty v. Lehigh Valley Railroad*, 160 U. S. 110, 40 L. ed. 358, that an element, (such as the fly-wheel in the case of the Vogt patent, or the male and female joints or fittings in the patent here in suit), cannot be interpolated into a claim either for the purpose of making out a case of novelty or infringement.—

“* * * There is no suggestion in either of these claims that the ends of the bolster rest upon springs in the side trusses, although they are so described in the specification and exhibited in the drawings. It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement.”

(160 U. S., at p. 116.)

The foregoing decision has been cited and followed in almost innumerable cases. An example is *U. S. Peg Wood, S. & L. B. Co. v. B. F. Sturtevant Co.*, 122 F. 470, where at p. 472 it is said:—

“The Lewis machine has a capacity for adjustment which the Pulsifer machine did not have, but that capacity for adjustment forms no part of the claim in issue, and is not referred to in the claim, and cannot now be imported into it for the purpose of enlarging and changing its general meaning and scope.”

We are unable to find in appellee's brief any direct reference whatever to any of the language or words of patent claims 1, 2 or 3 upon which appellee relies or can rely as even in the remotest suggesting that the composite pipe is made in sections or that each section is provided at opposite ends with male and female fittings or joints. It is so clear that it is indisputable there is nothing in either of patent claims 1, 2 and 3 even remotely suggesting that these features are a part of the combination particularly pointed out or claimed by either of said patent claims. Analyzing and considering claims 1, 2 and 3 of the Stadtfeld patent in the manner in which the claims of the Vogt patent were considered and construed by the Supreme Court in the *Altoona Pub. Theatres* case demonstrates that there is no substantial ground for contending that either of the features of making the pipe in sections or providing male and female joints for connecting the sectional pipes was comprehended as a part of the combination of either of said patent claims. The total failure

of appellee's brief to attempt to set forth anything in either of said patent claims upon which appellee relies as even inferentially referring to sectional pipes or to the respective ends thereof being provided with male and female joints or fittings, is a confession of the impossibility of sustaining any such combination.

The decision in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.* is so clearly applicable to and determinative of this case that further citation of authority thereon should be unnecessary.

The fact that Stadtfeld attempted to claim and to patent a combination including the pipe sections with male and female joints at the respective ends of the pipe sections (*Cf.* Appellant's Opening Brief, pp. 12-13), and that such claims were rejected as anticipated, is of moment here mainly (if not solely) to emphasize that the failure to patent, in the Stadtfeld patent as granted, a combination of which such male and female joints were parts or elements was (1) not an oversight on the part of Stadtfeld; (2) to emphasize that such combination was recognized by Stadtfeld to be and it is separate and distinct from the combination patented by claims 1, 2 and 3; and (3) that the attempt to add or include these male and female fittings, as well as to further modify the combination of patent claims 1, 2 and 3 to cover sectional pipes so provided with such male and female joints, is within the inhibition of the disclaimer statute, as directly pointed out in the *Altoona Pub. Theatres v. Amer. Tri-Ergon* case.

It is not material, in order to determine the invalidity of the disclaimer, to determine or consider the exact ground of estoppel arising where an applicant for a patent made a claim for a combination, (such as Stadtfeld's application claims 3, 4 and 5 or his additional application claim 8—*Cf.* Appellant's Opening Brief, p. 13,) and such claim has been rejected upon prior patents as anticipated and the applicant acquiesces in such rejection and cancels such claim. It is clearly established that such estoppel goes to the extent of thereafter barring Stadtfeld or his successors in interest from claiming that the combination embraced by such rejected claims was an original invention of Stadtfeld. It is effective also to illustrate that merely combining or adding such rejected combination, (so admitted not to be Stadtfeld's invention,) to the combination of patent claims 1, 2 and 3, (of which the disclaimer admits Stadtfeld was not the original or first inventor,) is not patentable invention. Stadtfeld and appellee have admitted that the male and female joint combination was not Stadtfeld's invention and have also by the disclaimer admitted Stadtfeld was not the original and first inventor of the combination of patent claims 1, 2 and 3. Appellee is in an inextricable dilemma. If it contends that adding the male and female joint combination to the composite pipe combination of patent claims 1, 2 or 3 rises to the dignity of patentable invention, it necessarily admits (that which is the fact) that thereby there is created a new and different combination from the combination of patent claims 1, 2 and 3, and appellee falls

condemned by the *Altoona Pub. Theatres v. Amer. Tri-Ergon* decision.—

“While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination.” (294 U. S. p. 490.)

Respectfully submitted,

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